IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: WALLACH17A

In re Application of:	)	Conf. No.: 3196
	)	
David WALLACH et al	)	Art Unit: 1646
	)	
Appln. No.: 10/035,408	)	Examiner: GS Emch
	)	
Filed: January 4, 2002	)	Washington, D.C.
	)	
For: MODULATORS OF REGULATORY PROTEINS	)	December 27, 2005
	)	

RESPONSE

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

The present communication is responsive to the official action of September 26, 2005. Claims 34-36 and 39-56 presently appear in this case. Claims 35, 36, 41-49 and 51-56 have been objected to but have been indicated to be allowable if rewritten in independent form. The remaining claims have been rejected. The official action of September 26, 2005, has now been carefully studied. Reconsideration and allowance are hereby respectfully urged.

Briefly, the present invention relates to a method for isolating and identifying polypeptides capable of binding to the death domain motif of a regulatory protein containing a

death domain. The method involves assaying polypeptides to be tested for binding to the death domain motif of the regulatory protein and then isolating and identifying any polypeptide that binds to that motif. The regulatory protein is NGF-R, MORT-1 or ankyrin 1.

Claims 34-36, 40-42, 45, 48, 51, 54 and 56 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. patent 6,808,891. The examiner states that a timely filed terminal disclaimer may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

Attached hereto is terminal disclaimer with respect to patent 6,808,891, thus obviating this rejection.

Claims 34, 36 and 48 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of co-pending application 10/368,438.

Claim 13 of application 10/368,438 will be deleted from that application at the time that a response is filed to the outstanding restriction requirement. Deletion of this claim will obviate the provisional rejection. Accordingly, it

is requested that this rejection be held in abeyance until claim 13 of application 10/368,438 has been deleted.

Claims 34, 36 and 48 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending application no. 10/998,582. This rejection is respectfully traversed.

On even date herewith an amendment is being filed in 10/998,582 deleting claim 4. Accordingly, the grounds for this obviousness-type double patenting rejection has now been obviated. Reconsideration and withdrawal thereof are respectfully urged.

Claims 34, 39, 40 and 50 have been rejected under 35 U.S.C. §102(b) as being anticipated by Horvath. The examiner states that Horvath teaches studies in which fibroblasts expressing each of the trk NGF receptors were crosslinked with iodinated NGF, and the crosslinked trk species were immunoprecipitated with polyclonal antibodies specific for the cytoplasmic domain of trk. The examiner states that, since the death domain of NGF-R is located in the cytoplasmic domain, it is an inherent property of the antibodies and methods taught by the Horvath reference to bind the death domain and thus meet the limitations of the polypeptides capable of binding to the death domain motif of NGF-R and the

assaying, isolating and identifying steps of the claims. This rejection is respectfully traversed.

Horvath teaches the use of polyclonal antibodies against the cytoplasmic domain of an NGF-R so as to immunoprecipitate the crosslinked trk species. While some of these antibodies may, indeed, inherently bind to the death domain of this receptor, the procedure of Horvath cannot be considered to be an assay for binding and certainly there is no disclosure of isolating and identifying any single polypeptide that specifically binds to the death domain motif. The polyclonal antibody is a mixture of a plurality of antibodies. Each one will bind to a different epitope on the cytoplasmic domain of the receptor. Claim 34 requires the isolation and identification of that particular polypeptide, i.e., antibody in the case of Horvath, that binds to the death domain motif of the regulatory protein. Horvath does not disclose isolating and identifying any specific polypeptide that binds to that motif. The examiner is correct that it may well be inherent that among the myriad of antibodies in the polyclonal serum one or more of them might bind to the death domain motif, but, without the step of isolating and identifying that antibody that binds to that motif, the isolating and identifying step of claim 34 is not met by Horvath. Accordingly, claim 34 and those claims that depend

therefrom are not anticipated by Horvath. Reconsideration and withdrawal of this rejection are respectfully urged.

It is submitted that all of the claims now present in the case clearly define over the references of record. Reconsideration and allowance are, therefore, earnestly solicited.

Respectfully submitted,

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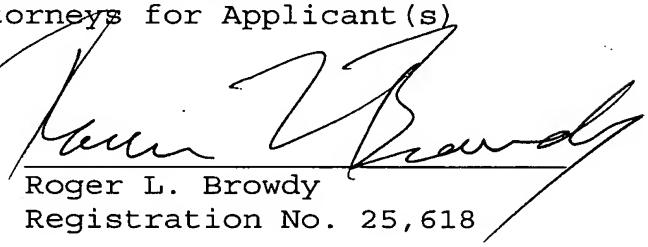
Attorneys for Applicant(s)

By 
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